

REMARKS/ARGUMENTS

In response to the to the Notice of Non-Compliant Amendment mailed August 24, 2005, Applicants submit a listing of all pending claims, including withdrawn claims.

In response to the Restriction Requirement mailed June 26, 2003, Applicants elect with traverse Group III, claims 1-16 and 19, drawn to a method for identifying a compound that modulates T lymphocyte activation *in vitro*, wherein the compound is a small organic molecule.

The foregoing election is made with traverse. Applicants request that Groups I-IV be examined together, as claim 1 is a genus claim to methods of identifying compounds that modulate T lymphocyte activation, as described below. Furthermore, Applicants request that Groups V and IV be examined together with Groups I-IV. The elected claims recite a method for identifying a compound that modulates T lymphocyte activation *in vitro* by examining the functional effect of the compound on the polypeptide. Group V recites methods of determining a phenotypic or chemical effect, and Group VI recites determining a physical effect. As described below, all the required method steps in Groups V and VI are also found in elected Group III.

Applicants assert that, at the very least, claim 1 is a genus claim linking the dependent species claims reciting methods of testing antibodies, antisense molecules, peptides, and small organic molecules, which methods require the same steps. Furthermore, all the required method steps in Groups V and VI are found in claim 1 of elected Group III. As such, upon allowance of a linking genus claim, the restriction requirement should be withdrawn with respect to the species claims. MPEP 809.03. Applicants further note that when the requirement for restriction is predicated upon the non-allowability of a generic linking claim, Applicant is entitled to retain in the case claims to the non-elected invention. If the generic linking claim is allowed, the Examiner must then examine non-elected claims to species falling within the genus. MPEP 809.04.

Finally, restriction of an application is discretionary. A restriction requirement is made to avoid placing an undue examination burden on the Examiner and the Office. Where claims can be examined together without undue burden, the Examiner must examine the claims on the merits even though they are directed to independent and distinct inventions. MPEP

Appl. No. 09/998,667
Amdt. dated September 15, 2005
Response to Notice of Non-Compliant Amendment

PATENT


803.01. Applicants respectfully submit that examining the claims of Groups I-VI together would not place and undue burden on the Examiner. Applicants therefore respectfully request that the restriction requirement with respect to Groups I-VI be withdrawn.

CONCLUSION

In view of the foregoing, examination at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 925-472-5000.

Respectfully submitted,


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